

## REMARKS

Claim 12 has been amended to require the applicator of Claim 11 have a massaging structure selected from the group consisting of, *inter alia*, rotating or rolling balls, rotating or rolling cylinders, and rotating or rolling rods. Further, Claim 12 has been amended to require that the three-dimensional patterns be embossed in a solid material, engraved in a solid material, and formed in a solid material. Support for the current Amendment to Claim 12 is found in the Specification beginning on page 52, line 31 to page 53, line 7. No new matter has been added to amended Claim 12.

Claims 1-2, 4-9, and 11-20 remain in the present Application and are presented for the Examiner's reconsideration in light of the following comments.

### Objections to the Drawings

The Examiner has objected to the drawings under 37 C.F.R. §1.84(h)(3) because Figs. 2 and 11 are not provided with cross-sectional hatching. Pursuant to M.P.E.P. §§608.02(p) and 608.02(h), Applicants herein are submitting a complete set of drawings detailing all figures originally presented in the case and also providing Figs. 2 and 11 with the required hatching. A courtesy copy of the corrected drawings is being provided for the Examiner's convenience herein. Therefore, Applicants respectfully request withdrawal of the Examiner's objection to the drawings.

### Objections to the Specification

The Examiner has objected to Applicants' disclosure as to what structure constitutes such "a first side having a first internal surface and a first external surface," and as to "what structure constitutes such a second side having a second internal surface and a second external surface."

The Examiner is respectfully reminded that Federal Circuit case law requires that claim language should not be construed in lexicographic vacuum but in the context of the specification or drawings. *See Vitoro Co. v. White Consolidated Ind., Inc.*, 199 F.3d 1295; 53 U.S.P.Q.2d 1065 (Fed.Cir. 1999). It is fundamental that claims are to be construed in light of the specification and claims, and both are to be read with a view to ascertaining the invention. *See Id.* (citing *Adams v. U.S.*, 383 U.S. 39, 49; 86 Sup.Ct. 708 (1966)). However, "It is not required that the application describe the claim limitations in greater detail than the invention warrants." *Martin v. Meyer*, 823 F.2d 500, 3 U.S.P.Q.2d 1333 (Fed.Cir. 1987). The description must be sufficiently clear that persons of skill in the art will recognize that the applicant made the invention having those limitations. *Id.* However, an *ipsis verbis* disclosure is not required to satisfy the written description requirement. *See*

*Fujikawa v. Wattanasin*, 93 F.2d 1559, 39 U.S.P.Q.2d 1895 (Fed.Cir. 1996). In other words, the disclosure needs only reasonably convey to persons of skill in the art that the inventor had possession of the subject matter in question. *Id.* USPTO procedure states that, “A claim term which has no antecedent basis in the disclosure is not necessarily indefinite.” *See M.P.E.P. §2173.05(f).* Finally, USPTO procedure states that, “There is no *in haec verba* requirement in regard to support of claim limitations.” *See M.P.E.P. §2163(I)(B).*

Applicants’ claimed subject matter is believed to be described in the Specification in such a way as to enable one skilled in the art to make and/or use the invention. For example, the Examiner is respectfully directed to Applicants’ drawing (Fig. 2) to provide Applicants’ support for all claim limitations.

Additionally, Applicants’ disclosure beginning on page 8, line 27, provides for one of skill in the art the understanding that a mitt having a front outer surface, a front inner surface, a back outer surface, and a back inner surface would describe “a first side having a first internal surface and a first external surface” and “a second side having a second internal surface and a second external surface,” as Applicants claim. Based upon a fair reading of Applicants’ Specification, Claims, and drawings, Applicants respectfully request the Examiner withdraw this objection.

The Examiner has objected to Applicants’ Specification on page 40, line 10, because of the presence of the word “acheating.” Applicants are at a loss to find this error. The paragraph beginning on page 40, line 10, reads, “In another embodiment, Figures 44 and 45, of a heating element may include use of aqueous salt solution(s) supercooled so that the heat packs can be carried in the supercooled condition and activated with internal release of heat when desired. Sodium acetate, sodium thiosulfate and calcium nitrate tetrahydrate are examples of suitable salts.” Applicants request removal of the Examiner’s objection.

The Examiner has required correction of Applicants’ Specification on page 60, line 17, wherein Applicants’ Figure 53 should read “Figure 57.” The sentence beginning on page 60, line 17, reads, “Figure 53 shows a cross-section of one embodiment of a mitt or glove near the cuff region 422.” This is entirely consistent with Applicants’ description of the drawings on page 6, line 31, wherein “Figure 53 is a cross-sectional view of the mitt in figure 57 taken along line 53-53.” Applicants respectfully request removal of the aforementioned Examiner’s objection.

#### Rejections Under 35 U.S.C. §112

Claims 1, 2, 4-9, and 11-20 have been rejected under 35 U.S.C. §112, ¶1 for not reasonably providing enablement for “at least one . . . opening.” The Examiner is respectfully directed to settled

Federal Circuit law where the court has said that, “We repeatedly emphasize that an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the traditional phrase ‘comprising.’ Unless the claim is specific as to the number of elements, the article ‘a’ receives a singular interpretation only in rare circumstances when the patentee evinces a clear intent to so limit the article.” *See Scanner Techs. Corp. v. ICOS Vision Sys. Corp.*, Fed. Cir., No. 03-1465, 4/23/04 (citing *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 55 U.S.P.Q.2d 1835 (Fed. Cir. 2000) (Emphasis Added).

Again, Applicants direct the Examiner to the Specification on page 8, line 14, where Applicants define “semi-enclosed applicator” to refer to “an applicator device having at least one externally-accessible internal cavity for receiving a portion of human anatomy. . . .” Applicants respectfully request withdrawal of the Examiner’s 35 U.S.C. §112, ¶1 rejection to Claims 1, 2, 4-9, and 11-20 therefor.

Claims 1, 2, 4-9, and 11-20 have been rejected under 35 U.S.C. §112, ¶1 for lacking description of “an activatable temperature changing element.” Applicants are at a complete loss to understand this rejection. Again, the Examiner is reminded that, “It is not required that the application describe the claim limitations in greater detail than the invention warrants.” *See Martin v. Meyer*, 823 F.2d 500, 3 U.S.P.Q.2d 1333 (Fed.Cir. 1987). In this regard, Applicants believe the Specification to be replete with references to temperature changing elements embodied in the form of heating/cooling elements, as described beginning on page 3, line 27 to page 43, line 9. Further, Applicants’ drawings also reflect temperature changing elements as evinced by Figures 26-45, inclusive, and so described in the BRIEF DESCRIPTION OF THE DRAWINGS.

With regard to Applicants’ use of the term “activatable temperature changing element,” Applicants respectfully direct the Examiner to page 34, line 20, where “The heating/cooling system, for example, may include a rupturable pouch 240 that contain(s) a first component of the heating/cooling system.” The Specification goes on at line 26 to say, “The rupturable pouch 240 may include a frangible seal 242 to allow a user to rupture the seal by squeezing or otherwise applying pressure to the heating/cooling element and to release the first component from the rupturable pouch.” In light of the abundant disclosure, Applicants respectfully request withdrawal of the Examiner’s 35 U.S.C. §112, ¶1 rejection to Claims 1, 2, 4-9, and 11-20 in that these claims are not directed to new matter.

Claims 1, 2, 4-9 and 11-20 have been rejected under 35 U.S.C. §112, ¶1 for not reasonably providing enablement for “a temperature changing element”; that is, an element capable of changing its temperature. Again, Applicants respectfully traverse this rejection by respectful direction of the Examiner to page 34, line 18, wherein Applicants state, “The heating/cooling system may include at least two components of a solid-liquid or a liquid-liquid heating system housed within the moisture

impermeable outer layer 246.” Further, the Examiner is respectfully directed to page 36, line 20, wherein Applicants state:

Another embodiment of a heating/cooling element includes a solid-liquid and/or liquid-liquid heating/cooling system such as shown in Figures 28, 29, 32 - 35 and 38 – 41 in which multiple components of the system can be housed in adjacent chambers separated by a rupturable barrier 242 such as a frangible seal or other rupturable barrier such as described above. The heating/cooling element, for example, may include a water impermeable outer layer 246 formed into a pouch having two or more chambers that separately house at least a first component and a second component of the system prior to activation. Upon compression of one or more chambers of the heating/cooling element, the rupturable barrier 242 may burst and allow the first and second component(s) to come into contact with each other.

Therefore, in light of this disclosure, Applicants reasonably believe that enablement is provided for a “temperature changing element”; that is, an element capable of changing its temperature and request withdrawal of the Examiner’s 35 U.S.C. §112, ¶1 rejection to Claims 1, 2, 4-9, and 11-20 forthwith.

Claims 3 and 4 have been rejected under 35 U.S.C. §112, ¶1 because the “disclosure fails to support [an] embodiment which utilizes the ‘temperature changing element’ . . . used for ‘cleaning, moisturizing, conditioning, or otherwise treating the skin, hair, or nails’, as called for by claim 3.” Applicants are at a loss to understand this rejection, as Claim 3 was canceled by Amendment previously. Applicants respectfully request withdrawal of this rejection to Claim 3 under 35 U.S.C. §112, ¶1.

With respect to Claim 4, again Applicants respectfully direct the Examiner to the Specification on page 9, line 8 to page 50, line 4 for the required support. Additionally, Applicants respectfully direct the Examiner to page 41, line 4, wherein Applicants state, “In order to heat or cool a product within a reservoir 30, the heating/cooling element such as the heating/cooling pouch 302 may be located in intimate contact with the reservoir 30 such as shown in Figure 51 to allow for efficient conductive heat transfer. This may be accomplished by the reservoir 30 and the heating/cooling pouch 302 in contact adjacent to each other when the mitt is combined, or the reservoir 30 and the heating/cooling pouch 302 may be adhered together with an adhesive or other bonding method known in the art.” Again, Applicants reasonably believe Claim 4 to be supported by Applicants’ Specification, as originally filed and therefore request withdrawal of the Examiner’s 35 U.S.C. §112, ¶1 rejection to Claim 4.

Claims 4 and 5 have been rejected under 35 U.S.C. §112, ¶1 because the claim elements are directed to new matter. Applicants are at a complete loss to understand this rejection, as Applicants’

originally filed Claim 4 claimed, "The applicator of Claim 1, wherein said product is selected from the group consisting of face cleansers, body cleansers, toners, lotions, moisturizers, ointments, cosmetics/make-ups, medicaments, and related topically applied treatments." Since the claims of the originally filed Application are indeed part of the Specification, the limitations presented in Claim 4 cannot be new matter as a matter of law. Additionally, Applicants respectfully refer the Examiner to the Specification on page 9, line 8, and extending to page 50, line 4, for the required support for these claim limitations. Applicants respectfully request withdrawal of the Examiner's 35 U.S.C. §112, ¶1 rejection to Claim 4.

Claims 4 and 5 have been rejected under 35 U.S.C. §112, ¶1 for Applicants' use of the claim limitation "and combinations thereof," as presented in Claim 4. Applicants respectfully traverse this rejection and direct the Examiner's attention to the Specification on page 63, line 27, where Applicants state that, "While particular embodiments of the present invention have been illustrated and described, it will be obvious to those skilled in the art that various changes and modifications may be made without departing from the spirit and scope of the invention. One skilled in the art will also be able to recognize that the scope of the invention also encompasses **interchanging various features** of the embodiments illustrated and described above." (Emphasis Added) In light of this disclosure, Applicants respectfully request withdrawal of the Examiner's 35 U.S.C. §112, ¶1 rejection to Claim 4 herewith.

Claim 12 has been rejected under 35 U.S.C. §112, ¶1 for not reasonably providing enablement for "balls, cylinders, rods as called for by claim 12." Additionally, Claim 12 has been rejected under 35 U.S.C. §112, ¶1 for not providing enablement for Applicants' claim limitation "within." By Amendment herein, Applicants have amended Claim 12 to require rotating a rolling ball, rotating a rolling cylinder, or rotating or rolling rods. Additionally, Applicants have amended Claim 12 to require three-dimensional patterns to be embossed in a solid material, engraved in a solid material, and three-dimensional patterns formed in a solid material. In light of the above Amendments, Applicants respectfully request removal of the Examiner's 35 U.S.C. §112, ¶1 rejections to Claims 12 herewith.

Claim 14 has been rejected under 35 U.S.C. §112, ¶1 for being directed to new matter. Applicants respectfully traverse this rejection and direct the Examiner's attention to the Specification beginning on page 41, line 28. In particular, the Specification states:

In some embodiments, it may also be desirable that the product exit from the reservoir 30 onto the heating/cooling pouch 302. For example if the mass of the product released is small, the temperature of the product may change in temperature quickly as it is applied to a cooler surface. If the product is released

onto the heating/cooling pouch 302, however, **the heating/cooling pouch may be pressed against the target surface as the product is applied.** Thus, the actual contact of the heating pouch 302 to the surface may provide an additional conductive heating/cooling effect. (Emphasis Added)

Additionally, Applicants' Specification beginning on page 40, line 31, states, "A heating/cooling element may also be **located adjacent to one or more substrates of the mitt 10,** for example between the front outer surface 31 and the front inner surface 32, between the back outer surface 33 and the back inner surface 34, **or adjacent to one or more of the front outer surface 31, the front inner surface 32, the back outer surface 33 and the back inner surface 34.**" (Emphasis Added) In light of this abundant disclosure, Applicants respectfully request withdrawal of the Examiner's 35 U.S.C. §112, ¶1 rejection to Claim 14 herewith.

Claims 17-20 have been rejected under 35 U.S.C. §112, ¶1 because "the original disclosure fails to describe or support such a self-enclosed temperature changing element or that the temperature changing element is disposed within the product." Applicants respectfully traverse this rejection and direct the Examiner's attention to Applicants' Specification beginning on page 42, line 3. Applicants state, "The reservoir 30 and the heating/cooling pouch 302 may also be combined into a **single pouch 326** as shown with a plan view in Figure 48." (Emphasis Added) In light of this disclosure, Applicants respectfully request withdrawal of the Examiner's 35 U.S.C. §112, ¶1 rejection to Claim 17 herewith.

#### Rejection Under 35 U.S.C. §103

Claims 1, 2, 4-7, 9, 13, 15, and 16 have been rejected under 35 U.S.C. §103(a) over Sansonetti, U.S. Patent No. 4,087,675 in view of Cahill, U.S. Patent No. 3,116,732. Previous arguments regarding the *Sansonetti* and *Cahill* references remain in effect but will not be repeated for the sake of brevity. Applicants respectfully traverse this rejection for the following reasons:

1. Applicants claim a semi-enclosed applicator comprising, *inter alia*, a first side having a first internal surface, a second side, a rupturable reservoir containing a product located proximate to the first internal surface wherein the product is released from the reservoir to a target surface **through said first side.**
2. Contrary to Applicants' claimed invention, the *Sansonetti* reference provides a heated mitten 10 having an inner mitten 12 and a reservoir 18 for retaining hand cream 20 provided therein. (2:19-29)
3. When heat is applied to the inner mitten 12, the membrane 22 (forming reservoir 18) melts releasing a premeasured quantity of the hand cream 20 directly to a hand placed within the mitten. (2:29-35) The only function of the outer mitten 24 is to provide an open-ended heated

chamber 26 to provide heat to the inner mitten 12, thereby causing the cream to be applied to the human hand contained within the inner mitten 12. (2:36-44)

4. Thus, the *Sansonetti* reference never transmits a product through any surface of the mitten for deposition of same upon a target surface, much less through a first side as claimed by Applicants.

5. Further, the *Cahill* and *Sansonetti* references are silent with respect to providing a product to a surface external to the disclosed applicators by releasing the product from a reservoir disposed internal to the semi-enclosed applicator through the side of an applicator to a target surface upon the application of pressure to a reservoir containing the product.

6. While it is true that the target surface in the *Sansonetti* reference can be constituted by a person's hand, Applicants are at a loss to understand how a target surface placed within the disclosed structure can be construed to constitute a surface external to the disclosed device.

Because of these considerations, the *Sansonetti* and *Cahill* references do not suggest what Applicants claim as their invention. In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. *See Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286 (Fed.Cir. 2001). Further, absent any motivation to provide the deposition of a product to a target surface by transit through the first side in response to an application of pressure to a rupturable reservoir contained therein, the combination of the *Sansonetti* and *Cahill* references cannot render any of the rejected claims obvious. *See In re Fine*, 837 F.2d 1071 (Fed.Cir. 1988); M.P.E.P. §2143.01. Applicants therefore request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejection to Applicants' independent Claims 1, 13, and 17.

Because Claims 2, 4-9, 11-12, 14-16, and 18-20 all depend directly or indirectly from Applicants' independent Claim 1, 13, or 17, they contain all of their respective limitations. For this reason, Applicants submit that the arguments made above concerning the allowability of Claims 1, 13, and 17 are equally applicable to the rejection of Claims 2, 4-9, 11-12, 14-16, and 18-20 under 35 U.S.C. §103(a). Therefore, Applicants respectfully request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejections herewith.

#### Conclusion

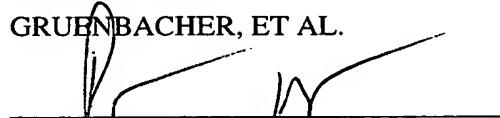
Based on all the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

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This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512.  
If any additional charges are due, the Examiner is authorized to deduct such charges from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

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